

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Brian J. Petryna
Serial No.: 09/940,783
Filed: August 28, 2001
Title: SYSTEM AND METHOD FOR AUTOMATICALLY ESTABLISHING
A TELEPHONE CALL OVER A COMPUTER NETWORK
Grp./A.U.: 2476
Examiner: Andrew Chung Cheung Lee
Confirmation No.: 3916

Commissioner for Patents
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ATTENTION: Board of Patent Appeals and Interferences

Sirs:

REINSTATEMENT OF APPEAL BRIEF UNDER 37 C.F.R. § 41.37

This is an appeal from a non-final Office Action electronically delivered January 22, 2010 (hereinafter “Office Action”), of Claims 1-21. As directed on page 2 of the Office Action, the Appellant initiated a new appeal with the Notice of Appeal of April 22, 2010 and hereby submits this Brief applying the previously paid statutory Appeal Brief fee of \$540.00 set forth in 37 C.F.R.

§41.20(b)(2) of October 23, 2009. The Appellant hereby authorizes the Commissioner to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 08-2395.

This Brief contains these items under the following headings, and in the order set forth below, in accordance with 37 C.F.R. §41.37(c)(1):

- i) REAL PARTY IN INTEREST
- ii) RELATED APPEALS AND INTERFERENCES
- iii) STATUS OF CLAIMS
- iv) STATUS OF AMENDMENTS
- v) SUMMARY OF CLAIMED SUBJECT MATTER
- vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- vii) APPELLANTS' ARGUMENTS
- viii) APPENDIX A – CLAIMS
- ix) APPENDIX B – EVIDENCE
- x) RELATED PROCEEDINGS APPENDIX

i) REAL PARTY IN INTEREST

The real party in interest in this appeal is Agere Systems Inc.

ii) RELATED APPEALS AND INTERFERENCES

Appellant does not know of any prior and pending Appeals, Interferences, or Judicial Proceedings directly related to, affecting, affected by, or have a bearing on the Board's decision in this appeal.

iii) STATUS OF THE CLAIMS

Claims 1-21 are rejected.

Herein, all rejections of Claims 1-21 are being appealed.

iv) STATUS OF THE AMENDMENTS

No amendments have been made in response to the Office Action and no amendments are pending.

v) SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1 relates a system for automatically initiating a subsequent telephone call over a computer network 160 from a second caller to a first caller. The system comprises an address interceptor 140 and a network call initiator for the second caller. The address interceptor 140 is associated with a circuit-switched telephone network 120 and receives calling number identification signals of the first caller from a first telephone call from the first caller to the second caller over the circuit-switched telephone network 120. The address interceptor 140 extracts from the received

calling number identification signals a destination address of a computer system 130 of the first caller for the subsequent telephone call from the second caller's computer system 150 back to the first caller. The network call initiator is coupled to the address interceptor 140. The network call initiator employs the destination address of the first caller's computer system 130 to automatically initiate the subsequent telephone call to the destination address of the first caller via the second caller's computer system 150 over the computer network 160. (*See, e.g.,* line 2 of page 8 through line 4 of page 10 and Fig. 1 of the original specification.)

Independent Claim 8 relates to a method of automatically initiating a subsequent telephone call over a computer network from a second caller to a first caller. The method comprises extracting a destination address of the first caller 430 and automatically initiating the subsequent telephone call 450 employing the destination address using a computer network to which both the first caller and second caller are connected to. The method extracts the destination address of the first caller from calling number identification signals received 410 from a first telephone call from the first caller to the second caller over a circuit-switched telephone network. Once the second caller has received the calling number identification signals from the first caller it then extracts the destination address of the first caller from the received calling number identification signals. (*See, e.g.,* line 6 of page 13 through line 17 of page 14 and Fig. 4 of the original specification.)

Independent Claim 15 relates to a computer 210 which includes a processor 212; a memory 213, display 220, and at least one input 222/224 coupled to the processor; a circuit-switched telephone network interface 214 coupled to the processor 212; a computer network interface 216 coupled to the processor 212; an address interceptor 215 coupled to the processor 212 and circuit-switched telephone network interface 214; and a network call initiator 217 coupled to the processor 212. The circuit-switched telephone network interface 214 receives a first telephone call from a first

caller over circuit-switched telephone network 230 that is coupled to the circuit-switched telephone network interface 214. The first telephone call includes calling number identification signals of the first caller. Address interceptor 215 extracts a destination address of the first caller from the calling number identification signals received by the circuit-switched telephone network interface 214. Network call initiator 216 uses the extracted destination address of the first caller and automatically initiates a subsequent telephone call to the first caller via computer network 240 to which the computer network interface 216 is coupled. (*See, e.g.*, line 5 of page 10 through line 19 of page 11 and Fig. 2 of the original specification.)

vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- (A) Whether Claim 1 complies with the written description requirement of 35 U.S.C. §112, first paragraph.
- (B) Whether Claim 8 complies with the written description requirement of 35 U.S.C. §112, first paragraph.
- (C) Whether Claim 15 complies with the written description requirement of 35 U.S.C. §112, first paragraph.
- (D) Whether Claims 2-7, 9-14, and 16-21 comply with the written description requirement of 35 U.S.C. §112, first paragraph.
- (E) Whether Claim 1 complies with the requirements of 35 U.S.C. §112, second paragraph.
- (F) Whether Claim 8 complies with the requirements of 35 U.S.C. §112, second paragraph.

(G) Whether Claim 1 is obvious over the combination of U.S. Patent No. 6,760,324 to Scott, *et al.* (hereinafter “Scott”) and U.S. Patent No. 6,760,020 to Hon (hereinafter “Hon”) as applied in the Office Action at pages 5-7.

(H) Whether Claim 8 is obvious over the combination of Scott and Hon as applied in the Office Action at pages 5-7.

(I) Whether Claim 15 is obvious over the combination of Scott and Hon as applied in the Office Action at pages 5-7.

(J) Whether Claims 2-7, 9-14, and 16-21 are obvious over the combination of Scott and Hon as applied in the Office Action at pages 7-8.

vii) APPELLANTS’ ARGUMENT

(A) **In Grounds of Rejection (A), the written description rejection of Claim 1 is improper because the limitations of Claim 1 which the Examiner alleges were not described in the original specification were described as noted below.**

At Item 2 at the middle of page 3 in the Office Action, the Examiner states:

...Regarding Independent claims 1, the amended claim subject matters of “subsequent telephone call over a computer network from a second caller to a first caller”, “calling number identification signal of said first caller”, “from said first caller to said second caller”, a destination address of said first caller”, and “subsequent telephone call over a computer network from said second caller to said first caller” are not disclosed and were not described in the specification at the time the application was originally filed.

Paragraph [0018] on page 8 of the original specification states (also described in Fig. 1 of the original specification):

...The telephone station 110 or the destination computer system 130 can initiate a telephone call to a recipient computer system 150 through the PSTN 120 and transmit calling number identification signals (“CNIS”) to PSTN 120. The CNIS, also referred to as “Caller ID,” includes a destination address that can be used by the recipient computer system 150 to initiate a call over a computer network 160 to the

destination computer 130 or a WEB telephone 170.

Thus, paragraph [0018] and Fig. 1 of the originally filed specification (and noted above in section v.) describes that a telephone station (or computer attached to it) can initiate a telephone call over a circuit-switched network such as PSTN 120 to a recipient computer system. The telephone station also transmits calling number identification signals to the PSTN with the call. The recipient computer station can then use a destination address included in the calling number identification signals to initiate a call over a computer network back to the destination computer.

In response to Office Actions in the prosecution, specifically the Office Actions of April 8, 2005, March 19, 2007, and March 13, 2008, the Appellant amended the independent claims (in the responses of July 8, 2005, January 19, 2007, and June 13, 2008, respectively) to more clearly point out the invention. As such, the telephone call described above from telephone station 110/destination computer system 130 over the PSTN 120 to the recipient computer system 150 was termed the “first call” and the call back from the recipient computer system 150 over the computer network to the destination computer system 130 was termed the “subsequent call.” Furthermore, the telephone station 110/destination computer system 130 was termed the “first caller” and the recipient computer system 150 was termed the “second caller.” The Appellant respectfully wishes to point out that the Examiner had every opportunity to reject these amendments under §112, first paragraph after their presentation but did not.

As such, at least the cited portions of the original specification disclosed presently pending independent Claim 1 recited below:

A system for automatically initiating a subsequent telephone call over a computer network from a second caller to a first caller, comprising:

an address interceptor, associated with a station of a circuit-switched telephone network, that receives calling number identification signals of said first caller from a first telephone call from said first caller to said second caller over said

circuit-switched telephone network and extracts from said calling number identification signals a destination address of said first caller for said subsequent telephone call from said second caller to said first caller...

Thus, for at least these reasons, pending independent Claim 1 complies with the requirements of 35 U.S.C. §112, first paragraph and, therefore, the rejection is improper.

(B) In Grounds of Rejection (B), the written description rejection of Claim 8 is improper because the limitations of Claim 8 which the Examiner alleges were not described in the original specification were described as noted below.

At Item 2 at the top of page 4 in the Office Action, the Examiner states:

Regarding Independent claims 8, the amended claim subject matters of “subsequent telephone call over a computer network from a second caller to a first caller”, “from said first caller to said second caller”, said destination address of said first caller” are not disclosed and were not described in the specification at the time the application was originally filed.

For the same reasons given above with regard to Grounds of Rejection (B), pending independent Claim 8 complies with the requirements of 35 U.S.C. §112, first paragraph and, therefore, the rejection is improper.

(C) In Grounds of Rejection (C), the written description rejection of Claim 15 is improper because the limitations of Claim 15 which the Examiner alleges were not described in the original specification were described as noted below.

At Item 2 at the middle of page 4 in the Office Action, the Examiner states:

Regarding Independent claims 15, the amended claim subject matters of “a first telephone call from a first caller”, “a destination address of said first caller”, a sequent (sic) telephone call to said first caller”, said destination address of said first caller” are not disclosed and were not described in the specification at the time the application was originally filed.

For the same reasons given above with regard to Grounds of Rejection (B), pending independent Claim 15 complies with the requirements of 35 U.S.C. §112, first paragraph and, therefore, the

rejection is improper.

(D) In Grounds of Rejection (D), the written description rejections of Claims 2-7, 9-14, and 16-21 are improper.

Claims 2-7

Claims 2-7 comply with the requirements of 35 U.S.C. §112, first paragraph, as applied by the Office Action, at least, by their dependence on pending independent Claim 1.

Claims 9-14

Claims 9-14 comply with the requirements of 35 U.S.C. §112, first paragraph, as applied by the Office Action, at least, by their dependence on pending independent Claim 8.

Claims 16-21

Claims 16-21 comply with the requirements of 35 U.S.C. §112, first paragraph, as applied by the Office Action, at least, by their dependence on pending independent Claim 15.

(E) In Grounds of Rejection (E), the indefiniteness rejection of Claim 1 is improper.

At Item 3 at the bottom of page 4 in the Office Action, the Examiner states:

Claims 1, 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter with applicant regards as the invention. It is not clear what/which a first caller and second caller is referring to. The drawings and the specification do not provide enough information and explicit description for whether a first caller or a second caller is a calling side (caller) and called side (callee), whether a first caller or a second caller is a plain old telephone (POT) or a personal computer.

As noted in Grounds of Rejection (A) above, paragraph [0018] and Fig. 1 of the original specification disclose that the telephone station 110/destination computer system 130 is the claimed first caller that places the claimed first call over the PSTN 120 to recipient computer system 150 which is the claimed second caller, which then places the claimed subsequent call back to the first caller over the claimed computer network.

As such, at least paragraph [0018] and Fig. 1 of the original specification provide sufficient description so that pending independent Claim 1 is definite. Thus, pending independent Claim 1 complies with the requirements of 35 U.S.C. §112, second paragraph and, therefore, the rejection is improper.

(F) In Grounds of Rejection (F), the indefiniteness rejection of Claim 8 is improper.

For at least the same reasons given in Grounds of Rejection (E) above, pending independent Claim 8 is definite. Thus, pending independent Claim 8 complies with the requirements of 35 U.S.C. §112, second paragraph and, therefore, the rejection is improper.

(G) In Grounds of Rejection (G), the obviousness rejection of Claim 1 is improper because it relies on Scott to teach features which are not taught in the cited portions of Scott.

At item 5 at the middle of page 5 of the Office Action, the Examiner states:

Regarding claims 1, 8, 15, Scott et al. disclose a system, method, computer for automatically initiating a telephone call over a computer network...

Claim 1 (and Claims 8 and 15) recite “A system for automatically initiating a subsequent telephone call over a computer network from a second caller to a first caller...” (Emphasis added.)

At item 5 at the bottom of page 5 and top of page 6 of the Office Action, the Examiner states:

...an address interceptor, associated with a station of a circuit-switched telephone network...that receives calling number identification signals of said first caller from a first telephone call from said first caller to said second caller over said circuit-switched telephone network...

Thus, the Examiner is asserting that cited portion of Scott teaches placing a first call from a first caller to a second caller.

At Item 5 at the middle of page 6 of the Office Action, the Examiner states:

Scott et al. also disclose a network call initiator (*interpreted as routing server*), coupled to said address interceptor and associated with a computer network terminal that employs said destination address to automatically initiate said subsequent telephone call to said destination address via said computer network terminal (“*all routes to be configured on the routing server, but automatically distributed to the appropriate gateways and can also distribute E.164 translation data*” *interpreted as associated with a computer network terminal that employs said destination address to automatically initiate said subsequent telephone call to said destination address via said computer network terminal*; Fig. 3B, col. 8, lines 60-64; element “*routing server*”; col. 9, lines 1-12; col. 59, lines 60-65; col. 61, lines 41-45; lines 17-19; lines 25-55; col. 70, lines 15-35). (Emphasis added.)

Thus, the Examiner asserts that the above cited portions of Scott teach employing a destination address to automatically initiate a subsequent phone call to a destination address via a computer network terminal.

At the next paragraph of the Office Action, the Examiner recognizes that Scott does not teach extracting from calling number identification signals a destination address and cites Hon to cure this deficiency.

The cited portions of Scott relied upon by the Examiner disclose a gateway server 210 used to interface between public switched telephone network (PSTN) 205 and an Internet Protocol (IP) network 215. The services provided by the gateway server 210 to, e.g.: properly route calls over IP network 215 (*see, e.g.*, line 60 of column 8 through line 12 of column 9 of Scott); select a service to handle an incoming call (*see, e.g.*, lines 60-65 of column 59 of Scott); assign users to a line group (*see, e.g.*, lines 17-19 of column 61 of Scott); use a privilege level to restrict routes (*see, e.g.*, lines 25-40 of column 61 of Scott); treat DNIS/DID information as the number the user wants to call (*see, e.g.*, lines 40-55 of column 61 of Scott); and translate digits entered by the user into E.164 form with an E.164 parser (*see, e.g.*, lines 15-35 of column 70 of Scott).

However, the cited portions of Scott do NOT teach initiating a subsequent telephone call via a computer network as presently claimed. Rather, the cited portions of Scott may teach the claimed

first telephone call.

The cited portions of Scott do not teach or suggest each and every element of independent Claim 1. As noted above, Hon has not been cited to cure this deficiency of Scott. For at least these reasons, the cited portions of the cited combination of Scott and Hon, as applied by the Examiner do not provide a *prima facie* case of obviousness for pending independent Claim 1 and, therefore, the obviousness rejection is improper.

(H) In Grounds of Rejection (H), the obviousness rejection of Claim 8 is improper because it relies on Scott to teach features which are not taught in the cited portions of Scott.

For at least the same reasons given above in Grounds of Rejection (G), the cited portions of the cited combination of Scott and Hon, as applied by the Examiner do not provide a *prima facie* case of obviousness for pending independent Claim 8 and, therefore, the obviousness rejection is improper.

(I) In Grounds of Rejection (I), the obviousness rejection of Claim 15 is improper because it relies on Scott to teach features which are not taught in the cited portions of Scott.

For at least the same reasons given above in Grounds of Rejection (G), the cited portions of the cited combination of Scott and Hon, as applied by the Examiner do not provide a *prima facie* case of obviousness for pending independent Claim 15 and, therefore, the obviousness rejection is improper.

(J) In Grounds of Rejection (J), the obviousness rejections of Claims 2-7, 9-14, and 16-21 are improper.

Claims 2-7

Claims 2-7 are non-obvious over the combination of Scott and Hon, as applied by the Office

Action, at least, by their dependence on pending independent Claim 1.

Claims 9-14

Claims 9-14 are non-obvious over the combination of Scott and Hon, as applied by the Office Action, at least, by their dependence on pending independent Claim 8.

Claims 16-21

Claims 16-21 are non-obvious over the combination of Scott and Hon, as applied by the Office Action, at least, by their dependence on pending independent Claim 15.

CONCLUSIONS

For the reasons set forth above, the Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner's Rejection of all of the Appellant's pending claims and allow issuance thereof.

Respectfully submitted,

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viii) APPENDIX A – CLAIMS

1. (Previously Presented) A system for automatically initiating a subsequent telephone call over a computer network from a second caller to a first caller, comprising:

an address interceptor, associated with a station of a circuit-switched telephone network, that receives calling number identification signals of said first caller from a first telephone call from said first caller to said second caller over said circuit-switched telephone network and extracts from said calling number identification signals a destination address of said first caller for said subsequent telephone call from said second caller to said first caller; and

a network call initiator, coupled to said address interceptor and associated with a computer network terminal, that employs said destination address of said first caller to automatically initiate said subsequent telephone call to said destination address via said computer network terminal.

2. (Original) The system as recited in Claim 1 wherein said calling number identification signals and said destination address are associated with a single location.

3. (Original) The system as recited in Claim 1 wherein said destination address is selected from the group consisting of:

a telephone number,

an Internet Protocol address,

a Voice over Internet Protocol (VoIP) gateway address, and

a VoIP gateway address combined with a telephone number.

4. (Original) The system as recited in Claim 1 wherein said computer network is the Internet.

5. (Original) The system as recited in Claim 1 wherein said station leaves unanswered a call transmitting said calling number identification signals.

6. (Original) The system as recited in Claim 1 wherein said calling number identification signals are associated with a second station, said second station hanging up after a predetermined number of unanswered rings.

7. (Original) The system as recited in Claim 1 wherein said station and said computer network terminal are embodied in a computer and wherein a single telephone line alternatively couples said station to said circuit-switched telephone network and said computer network terminal to said computer network.

8. (Previously Presented) A method of automatically initiating a subsequent telephone call over a computer network from a second caller to a first caller, comprising:

extracting a destination address for said subsequent telephone call from calling number identification signals received from a first telephone call over a circuit-switched telephone network from said first caller to said second caller; and

employing said destination address of said first caller to automatically initiate said subsequent telephone call to said destination address via said computer network.

9. (Original) The method as recited in Claim 8 wherein said calling number identification signals and said destination address are associated with a single location.

10. (Original) The method as recited in Claim 8 wherein said destination address is selected from the group consisting of:

a telephone number,
an Internet Protocol address,
a Voice over Internet Protocol (VoIP) gateway address, and
a VoIP gateway address combined with a telephone number.

11. (Original) The method as recited in Claim 8 wherein said computer network is the Internet.

12. (Original) The method as recited in Claim 8 further comprising leaving unanswered a call transmitting said calling number identification signals.

13. (Original) The method as recited in Claim 8 wherein said calling number identification signals are associated with a station, said method further comprising hanging up said station after a predetermined number of unanswered rings.

14. (Original) The method as recited in Claim 8 wherein said method is carried out in a computer and wherein a single telephone line alternatively carries said calling number identification signals and said destination address.

15. (Previously Presented) A computer, comprising:
a processor;
a memory coupled to said processor;
a display coupled to said processor;
at least one input device coupled to said processor;
a circuit-switched telephone network interface, coupled to said processor, for receiving a first

telephone call from a first caller over a circuit-switched telephone network couplable thereto, said first telephone call including calling number identification signals;

 a computer network interface, coupled to said processor, for allowing said computer to communicate over a computer network;

 an address interceptor, coupled to said processor and communicable with said circuit-switched telephone network interface, for extracting a destination address of said first caller for a subsequent telephone call to said first caller from said calling number identification signals; and

 a network call initiator, coupled to said processor, for employing said destination address of said first caller to automatically initiate said subsequent telephone call to said destination address of said first caller via said computer network interface.

16. (Original) The computer as recited in Claim 15 wherein said calling number identification signals and said destination address are associated with a single location.

17. (Original) The computer as recited in Claim 15 wherein said destination address is selected from the group consisting of:

 a telephone number,

 an Internet Protocol address,

 a Voice over Internet Protocol (VoIP) gateway address, and

 a VoIP gateway address combined with a telephone number.

18. (Original) The computer as recited in Claim 15 wherein said computer network is the Internet.

19. (Original) The computer as recited in Claim 15 wherein said circuit-switched telephone

network interface leaves said call unanswered.

20. (Original) The computer as recited in Claim 15 wherein a station placing said call hangs up after a predetermined number of unanswered rings.

21. (Original) The computer as recited in Claim 15 wherein said circuit-switched telephone network interface and said computer network interface are coupled to a single telephone line.

ix) APPENDIX B – EVIDENCE

The evidence in this appendix includes U.S. Patents to Scott, *et al.*, and Hon. Scott was entered in the record by the Examiner in the Office Action of April 28, 2005. Hon was entered in the record by the Examiner in Office Action of January 22, 2010.

x) RELATED PROCEEDINGS APPENDIX

NONE